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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,171	10/052,171 01/17/2002 Shinji Negishi		09792909-5310	3180
26263	7590 04/20/2005	EXAMINER		
SONNENSCHEIN NATH & ROSENTHAL LLP P.O. BOX 061080			STEVENS,	ROBERT
WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/052,171	NEGISHI ET AL.				
Office Action Summary	Examiner	Art Unit				
	Robert M Stevens	2176				
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
	Responsive to communication(s) filed on <u>17 January 2002</u> .					
3) Since this application is in condition for allowar	/ -					
Disposition of Claims						
 4) Claim(s) 1-76 is/are pending in the application. 4a) Of the above claim(s) 28-76 is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 1-27 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. 						
Application Papers						
9) ☐ The specification is objected to by the Examiner. 10) ☑ The drawing(s) filed on 17 January 2002 is/are: a) ☑ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:					

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DETAILED ACTION

- 1. Claims 1-76 are pending in Application No. 10/052,171, entitled "Conversion Apparatus and Method, Accounting Method, and Script Conversion System and Method", filed 1/17/2002 by Negishi et al.
- 2. This Office Action is in response the Election of Claims filed 2/28/2005.
- 3. Applicant has elected claims 1-27. Claims 1, 6, 10 and 22 are independent.
- 4. No Information Disclosure Statement has been filed as of the date of this communication.

Priority

5. Applicant claims benefit of Japanese application JAPAN P2001-009302 (filed 1/17/2001). Acknowledgment is made of applicant's claim for foreign priority based on this application. It is noted, however, that applicant has not filed a <u>certified copy</u> of the EP 0110595.4 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-10, 12-17, 21-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington et al (US Patent No. 6,775,820, filed Nov. 29, 2000 and issued Aug. 10, 2004, hereafter referred to as "Harrington") in view of Guthrie (US Patent No. 6,266,681, filed Apr. 8, 1997 and issued Jul. 24, 2001, hereafter referred to as "Guthrie").

Regarding independent claim 1, Harrington discloses:

A conversion apparatus (Fig. 3 and Fig. 4, esp. #410) receiving a document and a script as receiving data (Fig. 4 #404 and #406), comprising:

...; and

substitution means for substituting a script calling portion in the document with a portion for calling the script stored in said storage means. (Fig. 5 #520, 524, 528)

However, Harrington does not explicitly disclose:

storage means for storing at least the script extracted from the receiving data; and

Guthrie, though, discloses:

storage means for storing at least the script extracted from the receiving data; (Fig. 5 #505 and #509, it being merely a matter of obvious design choice as to what one stores and where one stores it) and

•••

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Regarding claim 2, which is dependent upon claim 1, Harrington further discloses:

wherein the script is embedded in or attached to the document. (Fig. 4 #406)

Regarding claim 3, which is dependent upon claim 2, Harrington further discloses:

wherein the document and the script are separately provided. (Fig. 4 #404 and Fig. 5 #520 re: Visual Basic Script, it being merely a matter of obvious design choice as to how one divides up the data to be processed.)

Regarding claim 4, which is dependent upon claim 1, Harrington further discloses:

wherein said conversion apparatus is provided in a relay server for sending and receiving data to and from a client. (col. 2 lines 55-58 and Fig. 1 #104, it being merely a matter of obvious design choice as to where one chooses to host any or all processing functions)

Regarding claim 5, which is dependent upon claim 1, the limitations of claim 1 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said storage means stores the document and the script.

Guthrie, though, discloses:

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wherein said storage means stores the document and the script. (Fig. 5 #505, #509 and #510, it being merely a matter of obvious design choice as to what one stores and where one stores it)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Independent claim 6 is directed to a method implemented by the apparatus of claim 1.

As such, this claim is substantially similar to claim 1, and therefore likewise rejected.

Claims 7-9 are substantially similar to claims 2-4, and therefore likewise rejected.

Regarding independent claim 10, Harrington discloses:

A script conversion system (Abstract), comprising:

a relay server for sending and receiving data to and from at least one client (col. 2 lines 55-58 and Fig. 1 #104 and #108), said script conversion system being used for requesting a document and displaying the requested document by said client, (Fig. 1 #108/110/112 and col. 2 lines 39-44 and col. 1 lines 6-10) said relay server (Fig. 1 #104, shows the well known use of servers, it being merely a matter of chains design shoice as to the number of servers.

being merely a matter of obvious design choice as to the number of servers employed and the functions hosted on each server) *comprising*:

conversion means for receiving a document and a script (Fig. 4 #404 and #406), extracting at least the script from the document (Fig. 5 #506/512/520/524/528) and

substituting a script calling portion in the document with a portion for calling the script stored in said storage means, (Fig. 5 #520/524/528) and outputting a resulting document as a converted document; (Abstract

discusses the converted document being compatible with OS/2 browsers [which output/display web documents]) and

script execution means for executing the script, (Abstract re: browsers) wherein said relay server sends the converted document to said client, (Fig. 1 #104 and 108, and col. col. 7 lines 55-63) and a script called by said client is executed by said script execution means. (Abstract re: browsers)

However, Harrington does not explicitly disclose:

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...:
....;
....:
.... and
the script and storing the script in storage means;
....; and
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Guthrie, though, discloses:

...:

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...,
....
.... and
the script and storing the script in storage means; (Fig. 5 #505 and #509, it being merely a matter of obvious design choice as to what one stores and where one stores it)
...; and
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It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Regarding claim 12, which is dependent upon claim 10, the limitations of claim 10 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said relay server receives the document directly from a document server in which documents are stored, or from said document server via an external recording medium.

Guthrie, though, discloses:

wherein said relay server receives the document directly from a document server in which documents are stored, or from said document server via an external recording medium. (col. 2 lines 30-45 discusses the use of multiple servers, it being merely a matter of obvious design choice as to where data is stored and the number of servers utilized)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Claim 13 is substantially similar to claim 2, and therefore likewise rejected.

Regarding claim 14, which is dependent upon claim 13, the limitations of claim 13 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said storage means comprises script storage means, and, when a display portion and the script, which form the document, are separately provided, said storage means stores the script in said script storage means, and the script

calling portion in the document is substituted with the portion for calling the script stored in said script storage means.

Guthrie, though, discloses:

wherein said storage means comprises script storage means, (Fig. 5 #509 and #505) and, when a display portion and the script, which form the document, are separately provided, (Fig. 5 #510, 509, it being merely a matter of obvious design choice as to where/how data is stored) said storage means stores the script in said script storage means, (Fig. 5 #509) and the script calling portion in the document is substituted with the portion for calling the script stored in said script storage means. (Fig. 5 #510)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Claim 15 is substantially similar to claim 12, and therefore likewise rejected.

Regarding claim 16, which is dependent upon claim 10, the limitations of claim 10 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said storage means comprises document storage means for storing at least the document, and said storage means stores the document and the script in said document storage means.

Guthrie, though, discloses:

wherein said storage means comprises document storage means for storing at least the document, (Fig. 5 #505) and said storage means stores the

document and the script in said document storage means. (Fig. 5 #505, 510, 509, it being merely a matter of obvious design choice as to where/how data is stored)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Regarding claim 17, which is dependent upon claim 10, Harrington further discloses:

wherein, when an execution result document obtain ed as a result of executing the script in said relay server is output, the execution result document is returned to said client, and is displayed in said client. (Abstract, discussing the converted document being compatible with OS/2 browsers [which display web documents])

Regarding claim 21, which is dependent upon claim 10, the limitations of claim 10 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said relay server serves the functions of a document server by storing the document in said relay server in advance.

Guthrie, though, discloses:

wherein said relay server serves the functions of a document server by storing the document in said relay server in advance. (Fig. 5 #500, 510, 509, it being merely a matter of obvious design choice as to where/how data is stored) Application/Control Number: 10/052,171

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It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Regarding independent claim 22, Harrington discloses:

A script conversion method (Abstract) for requesting from at least one to a document server to send a document via a relay server and displaying the requested document in said client (Abstract, col. 2 lines 55-58, Fig. 1 #104/108) and for displaying the received document (Fig. 1 #108, and col. 2 lines 39-45 and col. 1 lines 6-10), said script conversion comprising:

a conversion step of receiving the document and a script from said document server by said relay server, (Fig. 4 #404/406) extracting at least the script from the document and the script (Fig. 5 #506/512/520/524/528) ..., substituting a script calling portion with a portion for calling the script (Fig. 5 #520/524/528) ..., and ...; and

a script execution step of sending the converted document to said client and executing a script in the converted document called by said client. (Abstract, col. 2 lines 39-45 and col. 1 lines 6-10)

However, Harrington does not explicitly disclose:

... and storing the script in storage means, ... stored in said storage means, and outputting a resulting document as a converted document; and

Guthrie, though, discloses:

... :

... and storing the script in storage means, (Fig. 5 #500/509, it being merely a matter of obvious design choice as to what data is stored and where) ... stored in said storage means, (Fig. 5 #500/505/509) and outputting a resulting document as a converted document; (Fig. 5 #503/506/510) and

... .

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Claim 24 is substantially similar to claim 2, and therefore likewise rejected.

Regarding claim 25, which is dependent upon claim 24, the limitations of claim 24 have been previously addressed.

However, Harrington does not explicitly disclose:

said storage means comprises script storage means, and when a display portion and the script, which form the document, are separately provided, said conversion step stores the script in said script storage means, and substitutes the script calling portion with the portion for calling the script stored in said script storage means.

Guthrie, though, discloses:

said storage means comprises script storage means, and when a display portion and the script, which form the document, are separately provided, said conversion step stores the script in said script storage means, and substitutes the script calling portion with the portion for calling the script stored in said script storage means. (Fig. 5 #505/503/506/510/509, show storing of document and script in memory, it being merely a matter of obvious design choice as to the name and invocation time of a particular processing step, especially such a well known step like "storing of data")

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have

allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Claim 26 is substantially similar to claim 12, and therefore likewise rejected.

Regarding claim 27, which is dependent upon claim 22, the limitations of claim 2 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said conversion step comprises a document storage step and a script storage step, and said conversion step stores the document and the script in said document storage step.

Guthrie, though, discloses:

wherein said conversion step comprises a document storage step and a script storage step, and said conversion step stores the document and the script in said document storage step. (Fig. 5 #505/510/509, show storing of document and script in memory, it being merely a matter of obvious design choice as to the name and invocation time of a particular processing step, especially such a well known step like "storing of data")

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Guthrie for the benefit of Harrington, because to do so would have allowed a programmer into an existing document, as taught by Guthrie in the Abstract. These references were all applicable to the same field of endeavor, i.e., web-based programming.

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8. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington et al (US Patent No. 6,775,820, filed Nov. 29, 2000 and issued Aug. 10, 2004, hereafter referred to as "Harrington") in view of Guthrie (US Patent No. 6,266,681, filed Apr. 8, 1997 and issued Jul. 24, 2001, hereafter referred to as "Guthrie") and further in view of Sokolov (US Patent No. 6,823,504, filed Nov. 15, 2000 and issued Nov. 23, 2004, hereafter referred to as "Sokolov").

Regarding claim 11, which is dependent upon claim 10, the limitations of claim 10 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said storage means stores the document and the script.

Sokolov, though, discloses:

wherein said storage means stores the document and the script. (the use of portable communications terminals is well known in the art as evidenced by col. 1 lines 56-62)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Sokolov for the benefit of Harrington in view of Guthrie, because to do so would have allowed a system implementer to use a smaller memory footprint, as taught by Sokolov in col. 1 line 65 – col. 2 line 5. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Claim 23 is substantially similar to claim 11, and therefore likewise rejected.

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9. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington et al (US Patent No. 6,775,820, filed Nov. 29, 2000 and issued Aug. 10, 2004, hereafter referred to as "Harrington") in view of Guthrie (US Patent No. 6,266,681, filed Apr. 8, 1997 and issued Jul. 24, 2001, hereafter referred to as "Guthrie") and further in view of Underwood et al (US Patent No. 6,601,057, provisionally filed Nov. 5, 1999 and issued Jul. 29, 2003, hereafter referred to as "Underwood").

Regarding claim 18, which is dependent upon claim 10, the limitations of claim 10 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said client comprises ID information storage means for storing ID information which specifies a caller, and said relay server comprises authentication means for receiving the ID information from said client and for comparing the ID information with a list of ID information which is allowed to use said relay server, and wherein said authentication means determines whether said client is allowed to use said relay server based on an authentication result of said authentication means.

Underwood, though, discloses:

wherein said client comprises ID information storage means for storing ID information which specifies a caller, and said relay server comprises authentication means for receiving the ID information from said client and for comparing the ID information with a list of ID information which is allowed to use said relay server, and wherein said authentication means determines whether said client is allowed to use said relay server based on an authentication result of said authentication means. (Fig. 47A and col. 41 lines 5-7 discuss the well known function of user authentication)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Underwood for the benefit of Harrington in view of Guthrie, because to do so would have allowed one to easily change the look and feel of a web site, as taught by Underwood in col. 4 lines 8-12. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Regarding claim 19, which is dependent upon claim 18, the limitations of claim 18 have been previously addressed.

However, Harrington does not explicitly disclose:

further comprising accounting means for performing accounting to bill the which is determined to be allowed to use said relay server by said authentication means for the use of: a conversion function for receiving the document and the script extracting at least the script from the document and the script and separately storing the script in said storage means, substituting the script calling portion in the document with the portion for calling the script stored in said storage means, and outputting a resulting document as a converted document; and an execution for executing the script in the converted document called by said client.

Underwood, though, discloses:

further comprising accounting means for performing accounting to bill the which is determined to be allowed to use said relay server by said authentication means for the use of: a conversion function for receiving the document and the script extracting at least the script from the document and the script and separately storing the script in said storage means, substituting the script calling portion in the document with the portion for calling the script stored in said storage means, and outputting a resulting document as a converted document; and an execution for executing the script in the converted document called by said client. (Fig. 82 re: Billing, and col. 52 lines 23-50 discuss billing [i.e., accounting] functions)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Underwood for the benefit of Harrington in view of Guthrie, because to do so would have allowed one to easily change the look and feel of a web site, as taught by Underwood in col. 4 lines 8-12. These references were all applicable to the same field of endeavor, i.e., web-based programming.

Regarding claim 20, which is dependent upon claim 19, the limitations of claim 19 have been previously addressed.

However, Harrington does not explicitly disclose:

wherein said accounting means updates accounting in formation corresponding to the ID in formation every time said client uses the conversion function and the execution function.

Underwood, though, discloses:

wherein said accounting means updates accounting in formation corresponding to the ID in formation every time said client uses the conversion function and the execution function. (col. 52 lines 46-50 discuss billing [i.e., accounting] functions on a per user basis)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Underwood for the benefit of Harrington in view of Guthrie, because to do so would have allowed one to easily change the look and feel of a web site, as taught by Underwood in col. 4 lines 8-12. These references were all applicable to the same field of endeavor, i.e., web-based programming.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Non-patent Literature

Kanada, Yasusi, "Web Pages that Reproduce Themselves by JavaScript", <u>ACM SIGPLAN Notices</u>, V.32(11), Nov. 1997, pp. 49-56.

Kendall, Robert, et al., "Toward an Organic Hypertext", <u>Hypertext 2000</u>, San Antonio, TX, May 2000, pp. 161-170 (plus citation page).

Mockus, Audris, et al., "A Web-Based Approach to Interactive Visualization in Context", AVI 2000, Palermo, Italy, May 2000, pp. 181-188 (plus citation page).

Cruz, Isabel F., et al., "Publication and Customization of Electronic Documents Using PANDA", <u>Proceedings of the 17th annual international conference on Computer documentation</u>, New Orleans, LA, Oct. 1999, pp. 58-64 [ACM 1-58113-072-4/99/0009].

Bradenbaugh, Jerry, <u>JavaScript Application Cookbook</u>, O'Reilly & Associates, Sebastopol, CA, Oct. 1999, pp. 58 and 79.

Flanagan, David, <u>JavaScript: The Definitive Guide</u>, 2nd <u>Edition</u>, O'Reilly & Associates, Sebastopol, CA, Jan. 1997, pp. 243-247 and 281-310.

US Patent Application Publications

Emmelmann et al	US2003/0074634
Chittu et al	US2002/0107892
Dinovo et al	US2002/0069255
Gao et al	US2002/0107890

	US Patents
Tracton et al	6,470,370
Cason et al	6,681,229
Heninger et al	6,470,349
Apte et al	6,662,236
Guheen et al	6,519,571
Newman et al	6,085,229
Landsman et al	6,785,659
Tan et al	6,760,745
Haswell et al	6,502,102
Hoffman	6,189,137
Emura	6,453,340
Pettersen	6,826,594
Loomans	6,393,605
Smith	6,502,076

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The current fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Additionally, the main number for Technology Center 2100 is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens Reg. No. 47,972 Art Unit 2176

Date: April 14, 2005

rms